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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,505	11/21/2003	Kevin M. Bell	3018-001-27 Cont.	7613
33942 7590 04/29/2008 PATTON BOGGS LLP 8484 WESTPARK DRIVE SUITE 900 MCLEAN, VA 22102				
EXAMINER				
FRENEL, VANEL				
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3687				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/717,505

Applicant(s)

BELL ET AL.

Examiner

VANEL FRENEL

Art Unit

3687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the application filed on 11/21/03. Claims 1-21 are pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. More ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve use, or advance the technological arts to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bennett et al (5,815,392) in view of Wamsley et al (5,956,687).

(A) As per claim 1, Bennett discloses a method of managing complex litigation tasks by at least one user comprising: (1) providing an informational outline which may be necessary to be complete said tasks (Col.5, lines 25-67 to Col.6, line 42);

(2) querying said at least one user as to the relevance of each of said potential elements and receiving responses to said inquiries (Col.4, lines 64-67 to Col.5, line 18),

(3) removing from said informational outline those potential elements indicated by said responses to be not relevant (Col.5, lines 19-67 to Col.6, line 67; Col.13, lines 7-49), and

(4) generating an informational outline responsive to said task by assembling all said potential elements not removed in step 3 (Col.6, lines 22-67 to Col.7, line 41).

Bennett does not explicitly disclose that a method of managing complex litigation tasks by at least one user.

However, this feature is known in the art, as evidenced by Wamsley. In particular, Wamsley suggests a method of managing complex litigation tasks by at least one user (See Wamsley, Col.15, lines 21-67 to Col.16, line 67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the feature of Wamsley within the system of Bennett with the motivation of providing a technique for computerized management of personal injury claims (See, Wamsley, Col.4, lines 44-46).

(B) As per claim 2, Bennett discloses the method which further includes a step of permitting the at least one user to manually remove said potential elements from said informational outline prior to step 1 (Col.5, lines 25-67 to Col.6, line 42; Col.9, lines 64-67 to Col.10, line 65).

(C) As per claim 3, Bennett discloses the method wherein said method further comprises providing said user with the opportunity to view data relevant to each of said potential elements (Col.7, lines 41-67; Col.9, lines 33-67).

(D) As per claim 4, Bennett discloses the method wherein said data is segregated and correlated by association of portions thereof relevant to each said potential element (Col.9, lines 55-67 to Col.10, line 65).

(E) As per claim 5, Bennett discloses the method wherein said data is selected group consisting of document images, optical character recognition versions document images, deposition transcripts, deposition videotapes and mixtures thereof (Col.7, lines 42-54).

(F) As per claim 6, Bennett discloses the method wherein said method comprises a step of storing data associated with at least one potential element of said task in a local database (Col.10, lines 37-67 to Col.11, line 17).

(G) As per claim 7, Bennett discloses the method wherein said method further comprises the steps of associating notes concerning said data entered by a user with the data and storing said notes correlated with said data and said potential elements (Col.11, lines 1-56; Col.13, lines 1-27).

(H) As per claim 8, Bennett discloses the method wherein said complex task one or more tasks pertinent to a patent infringement litigation (Fig.3; Col.18, lines 37-67).

(I) As per claim 9, Bennett discloses the method wherein said task is the operation of complaint for patent infringement (Col.12, lines 31-50).

(J) As per claim 10, Bennett discloses the method wherein said task is the preparation of an answer to a complaint for patent infringement (Col.12, lines 7-67).

(K) As per claim 11, Bennett discloses the method wherein said task is the preparation a complaint seeking declaratory judgment of at least one of patent invalidity, patent unenforceability or non-infringement (Col.18, lines 53-67).

(L) As per claim 12, Bennett discloses the method wherein said task is the preparation of a counterclaim for patent infringement (Col.12, lines 7-67).

(M) As per claim 13, Bennett discloses the method wherein said task is the preparation of a litigation strategy for a party to a patent litigation (Col.12, lines 7-67).

(N) As per claim 14, Bennett discloses the method wherein said task is the preparation of at least a portion of a pleading, motion or other paper to be filed in a court art behalf of a party to a patent litigation (Col.18, lines 9-67).

(O) As per claim 15, Bennett discloses the method wherein said task is the completion of at least part of a document prepared in connection with said patent litigation which is not to be filed in court (Col.24, lines 22-67).

(P) As per claim 16, Bennett discloses the method wherein said document is a privilege log (Col.13, lines 7-34).

(Q) As per claim 17, Bennett discloses the method wherein said user is provided with a reference database which comprises the body of at least one Statute, Rule, Code advisory text, reference text, constitution or treaty, which can be queried in the course of completion said complex litigation task (Col.16, lines 9-43).

(R) As per claim 18, Bennett discloses the method wherein said reference database comprises at least one of the group consisting of the Federal Rules of Civil Procedure, Title 28 of the United States Code, Title 35 of the United States Code, Chapter 37 of the code of Federal Regulations, the Manual of Patent Examining Procedure, Black's Law Dictionary, the Federal Rules of Civil Procedure, the Federal Rules of Evidence, the Federal Rule of Appellate Procedure, the Manual of Complex Litigation, Chisum on Patents and Local Rules of the United States District Courts (Col.19, lines 17-26).

(S) As per claim 19, Wamsley discloses the method wherein at least some of said data is maintained on an accessible storage device, selected from the group consisting of the personal computer, a laptop computer, a networked server and an internet accessible server (Col.6, lines 32-67).

The motivation for combining the respective teachings of Bennett and Wamsley are as discussed above in the rejection of claim 1, and incorporated herein.

(U) As per claim 20, Wamsley discloses the method wherein said steps of providing, inquiring and receiving responses are effected by receiving output from a computing

device and said at least one user generating signals rendered intelligible to said computing device responsive to said output and inputting said signals to said computing device (Col.5, lines 53-67).

The motivation for combining the respective teachings of Bennett and Wamsley are as discussed above in the rejection of claim 1, and incorporated herein.

(V) As per claim 21, Wamsley discloses the method wherein said signal, intelligible to said computing device are produced by use of at least one of a pointing device, an electronic screen on which information may be portrayed, a keyboard, a microphone and an interface with a second computing device (Col.5, lines 53-67 to Col.6, line 55).

The motivation for combining the respective teachings of Bennett and Wamsley are as discussed above in the rejection of claim 1, and incorporated herein.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches system and method for on line resolution of disputes (2001/0037204), browsing method for focusing research (2002/0091836), management system for documents stored electronically (6,092,090) and legal strategic analysis planning and evaluation control system and method (5,875,431).

Art Unit: 3687

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 571-272-6769. The examiner can normally be reached on 6:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

/Vanel Frenel/
Examiner, Art Unit 3687

April 14, 2008